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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,320	02/06/2001	Patrick Page	1103326-0654	3650
7470	7590	01/13/2004	EXAMINER	
WHITE & CASE LLP PATENT DEPARTMENT 1155 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EPPERSON, JON D	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p>Application No.</p> <p>09/762,320</p>	<p>Applicant(s)</p> <p>PAGE, PATRICK</p>	
	<p>Examiner</p> <p>Jon D Epperson</p>	<p>Art Unit</p> <p>1639</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6-12 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

**Please note:** There is a change in Examiner handling prosecution in this case from Maurie G. Baker to Jon D. Epperson.

#### ***Status of the Application***

1. The Response filed October 20, 2003 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Status of the Claims***

3. Claims 1-16 were pending. Applicant amended claim 1. Therefore, claims 1-16 are still pending.
4. Claims 6-12 and 14-16 are drawn to non-elected species and thus these claims remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), there being no allowable generic claim.
5. Therefore, claims 1-5 and 13 are examined on the merits in this action.

#### ***Election/Restriction***

Art Unit: 1639

6. Applicant requests withdrawal of previous restriction requirement because the currently pending claims are novel with regard to Short et al. Consequently, pending claims share the same special technical feature (i.e., the covalent bond between the linker moiety and the isonitrile moiety cleaves when treated with acid), which is not disclosed or suggested by the Short et al reference. Thus, the claims of Groups I-IV are linked by unity of invention (e.g., see Paper filed October 20, 2003 especially page 12, last paragraph).

7. The Examiner's position is that the lack of unity with regard to Applicant's original claims was properly set forth by the previous Examiner. Furthermore, Applicant's newly amended claims are also anticipated (see rejection below) and, as a result, Groups I-IV lack a special technical feature. Therefore, the restriction is still deemed proper the finality is NOT withdrawn.

#### **Withdrawn Objections/Rejections**

8. All previous rejections and/or objections are withdrawn in view of Applicant's arguments and/or amendments.

#### **New Rejections**

#### ***Claims Rejections - 35 U.S.C. 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Arshady et al (Arshady, R.; Zecca, M.; Corain, B. "Polymeric isocyanides: synthesis, properties and applications" *Reactive Polymers* **1993**, *20*, 147-173).

For *claims 1-5*, Arshady et al (see entire document) disclose isocyanide compounds on a solid-support that falls within the scope of Applicant's claims (e.g., compare Applicant's claim 2 to Arshady et al, page 155, scheme 14/Table 2, compound 10a), which anticipates claims 1- 5. In this scenario, R<sup>1</sup>-R<sup>4</sup> is hydrogen, X is carbon and/or oxygen and the polymer is any of a variety of polystyrene resins. Furthermore, Arshady et al disclose that the polymer can be either a "soluble" or "insoluble" polymer (e.g., see section 4.1.1. and 4.1.2.). Although the reference does not explicitly state that the isonitrile moiety would be cleaved from the resin for compounds like 10a (e.g., see page 155, scheme 14/Table 2) within 30 minutes using 95% trifluoroacetic acid (e.g., see Applicant's arguments on page 11, paragraph 3), compound 10a has the same structure as that currently claimed by Applicant (see above) and, as a result, would possess the same chemical and/or physical properties. "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The Office does not have the facilities to make such a comparison and the burden is on the applicants to establish the difference. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray*, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arshady et al (Arshady, R.; Zecca, M.; Corain, B. "Polymeric isocyanides: synthesis, properties and applications" *Reactive Polymers* **1993**, 20, 147-173).

For *claims 1-5*, Arshady et al (see entire document) disclose isocyanide compounds on a solid-support that falls within the scope of Applicant's claims (e.g., compare Applicant's claim 2 to Arshady et al, page 155, scheme 14/Table 2, compound 10a), which anticipates claims 1- 5. In this scenario, R<sup>1</sup>-R<sup>4</sup> is hydrogen, X is carbon and/or oxygen and the polymer is any of a variety of polystyrene resins. Furthermore, Arshady et al disclose that the polymer can be either a soluble or insoluble polymer (e.g., see section 4.1.1. and 4.1.2.). Although the reference does not explicitly state that the isonitrile moiety would be cleaved from the resin within 30 minutes using 95% trifluoroacetic acid (e.g., see Applicant's arguments on page 11, paragraph 3), compound 10a has the same structure as that currently claimed by Applicant (see above) and, as a result, would possess the same chemical and/or physical properties. "When the PTO

shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The Office does not have the facilities to make such a comparison and the burden is on the applicants to establish the difference. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray*, 10 USPQ 2d 1922 1923 (PTO Bd. Pat. App. & Int.).

The prior art teachings of Arshady et al differ from the claimed invention as follows:

For *claim 13*, Arshady et al is deficient in that it does not disclose a kit.

However, packaging reagents disclosed to be useful for the same purpose in the form of a kit would have been obvious over Arshady et al for reasons of convenience and economy. Furthermore, one of ordinary skill in the art would have reasonably expected to be successful because packaging reagents together would decrease the time spent in collecting these items.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Jon D. Epperson, Ph.D.  
January 3, 2004

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JAN 13 2004  
FEDERAL BUREAU OF INVESTIGATION  
